AMENDMENT UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2124
PATENT
Application # 09/822,300
Attorney Docket # 2000P07515US01 (1009-087)

REMARKS

Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 1-6, 16, 17, 19-24, 34-36, 39-41, and 44-51 was amended for reasons unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification thereby not narrowing the scope of the claim, to detect infringement more easily, to enlarge the scope of infringement, to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.), to expedite the issuance of a claim of particular current licensing interest, to target the claim to a party currently interested in licensing certain embodiments, to enlarge the royalty base of the claim, to cover a particular product or person in the marketplace, and/or to target the claim to a particular industry. Claims 1-52 are now pending in this application. Claims 1, 19, 36, 39, 41, 44, and 51 are the independent claims.

I. The Statutory Subject Matter Rejection

Claim 36 was rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter because it recites a computer program. Applicant respectfully traverses. Claim 36 has been amended to make explicit that which was implicit when read by one of ordinary skill in the art. Reconsideration and withdrawal of the rejection of claim 36 is respectfully requested.

II. The Obviousness Rejections

Claims 1-5, 7-10, 12-13, 15-17, 19-23, 25-28, 30-32, 34-44, and 46-52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Lau (U.S. Patent No. 6,598,219) in view of Hoskins (U.S. Patent No. 6,167,406). These rejections are respectfully traversed.

Claims 6, 11, 14, 18, 24, 29, 33, and 45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Lau (U.S. Patent No. 6,598,219) in view of Hoskins (U.S. Patent No. 6,167,406), and further in view of Suzuki ("Making UML Models Exchangeable over the Internet with XML: UXF Approach"). These rejections are respectfully traversed.

AMENDMENT UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2124
PATENT
Application # 09/822,300
Attorney Docket # 2000P07515US01 (1009-087)

None of the cited references, either alone or in any combination, establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." See MPEP § 2143.

Apparent Official Notice

To the extent that Official Notice is taken to support the rejections of the present Office Action, Applicants respectfully traverse and request citation and provision of a reference that supports the rejection. See MPEP 2144.03. Specifically, page 4 of the Office Action recites the "use of models to represent real-world entities via an interfacing tool for building a business application program in a variety of domains of industry was a known concept at the time the invention was made. One such domain can vary from business related applications to manufacturing design or industrial automation control." Applicants respectfully request citation and provision of a reference that supports the apparent Official Notice taken in making that statement.

The present Office Action recites "[a]s per claim 1, Lau discloses a method for representing object and task-oriented computer program code" See page 3. Applicant respectfully requests a citation of where "Lau discloses ... task-oriented computer program code."

Alleged Inherent Elements

Further, the present Office Action asserts regarding claims 8 and 10 that "Lau disclose modeling (Fig. 1-2); hence has if not explicitly from the Figures shown, then **implicitly disclosed** graphical language comprising a flowchart, block diagram, and sequential diagram". See page 5. Regarding claim 16 the present Office Action recites: "Lau discloses an editing interface to enable

the user to perform creating a file and define the objects (e.g. Fig. 1-2; col. 5, lines 27-45; col. 6, line 16-10); hence has disclosed editor and generating screen objects which trigger **inherent** commands to generate of metadata in terms of XML or DTD formatted files". The alleged "implicitly disclosed" or "inherent" material is used for rejecting, for example, claims 8, 10, 12, 15, 16, 26, 28, 30, 32, and 35. Lau fails to properly establish inherent anticipation. See MPEP 2112. "Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002). No evidence has been presented that the "missing descriptive material is 'necessarily present'" in Lau.

Hoskins Teaches Away From the Cited Combination

Each of independent claims 1, 19, 36, 39, 41, 44, and 51 recite "code" and/or "programs" for "industrial automation" in a "markup language" version.

Hoskins allegedly recites that "HyperText Markup Language (HTML)" (see col. 11, lines 53-54) **"has proven to be inadequate** in the following areas:

- Poor performance;
- Restricted user interface capabilities;
- Can only produce static Web pages;
- Lack of interoperability with existing applications and data; and
- Inability to scale"

(see col. 12, lines 4-12).

Instead of HTML, **Hoskins praises non-mark-up languages** such as Java and Active X. See col. 12, lines 20-65.

Thus, Hoskins teaches away from using "a markup language" version of "industrial automation" code. References "that teach away cannot serve to create a prima facie case of obviousness." *See,* In re Gurley, 27 F.3d 551, 553, 31 U.S.P.Q.2D (BNA) 1130, 1132 (Fed. Cir. 1994). As a result, one of ordinary skill in the art would have no motivation to consider Hoskins for combination with Lau due to the inadequacies of HTML listed by Hoskins.

AMENDMENT UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2124
PATENT
Application # 09/822,300
Attorney Docket # 2000P07515US01 (1009-087)

The present Office Action acknowledges that a "missing feature by Lau is that the markup representation ... is not applied in the field of industrial automation. See Page 14-15. Thus, since Hoskins may not be properly combined with Lau, the cited references fail to establish a *prima facie* case of obviousness.

Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted. Consequently, reconsideration and withdrawal of these rejections is respectfully requested.

AMENDMENT UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2124
PATENT
Application # 09/822,300
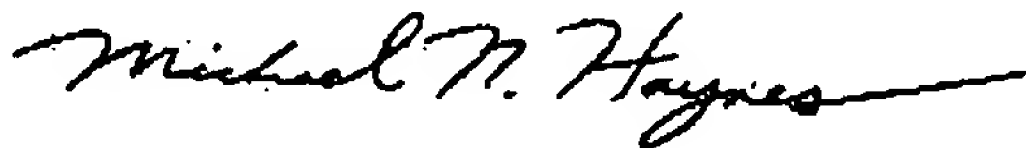Attorney Docket # 2000P07515US01 (1009-087)

CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC

Date: 25 March 2005

Michael N. Haynes
Registration No. 40,014

1341 Huntersfield Close
Keswick, VA 22947
Telephone: 434-972-9988
Facsimile: 815-550-8850